

Attorney Docket No.: DEX-0522  
Inventors: Salceda et al.  
Serial No.: 10/517,696  
Filing Date: November 4, 2005  
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#### REMARKS

Claims 1-16 were pending in the instant application. Claims 11-14 have been withdrawn from consideration by the Examiner and subsequently canceled by Applicants herein without prejudice. Claims 1-10, 15 and 16 have been rejected. Claim 1 has been amended. No new matter has been added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

#### **I. Rejection of Claims 1, 2, 4-10 and 16 under 35 U.S.C. 102(b)**

Claims 1, 2, 4-10 and 16 have been rejected under 35 U.S.C. 102(b) as being anticipated by Gendler et al. (J. Biol. Chem. 265:15286 (1990)). The Examiner suggests that Gendler et al. discloses a human breast cancer associated nucleic acid that shares 298 contiguous nucleic acids with SEQ ID NO:36 of the instant claims. The Examiner suggests that the discussion in Kennell in the paragraph bridging pages 260-261 makes clear that a duplex of this length has maximum stability and thus would hybridize under stringent nucleic acid molecular hybridization conditions. The Examiner suggests that at line 10 of page 261, Kennell stating "The thermal stability of a nucleic acid duplex is extremely sensitive to the presence of mismatch nucleotide pairs within the polymer strand" refers to mismatches occurring

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in the region of complementarity.

Applicants respectfully disagree with the Examiner's characterization of the teachings of Kennell and this rejection.

However, in an earnest effort to advance the prosecution of this case, Applicants have amended claim 1 to delete part (b).

Withdrawal of this rejection is respectfully requested.

## **II. Rejection of Claims 3 and 15 under 35 U.S.C. 103(a)**

Claim 3 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Gendler et al. (J. Biol. Chem. 265:15286 (1990)) in view of the state of art that isolation of genomic DNA once cDNA has been isolated is known.

Claim 15 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Gendler et al. (J. Biol. Chem. 265:15286 (1990)) in view of An et al. (U.S. Patent No. 6,218,529). The Examiner suggests that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the human breast cancer associated nucleic acid of Gendler et al. as a cancer marker in the manner taught by An et al. in order to detect and/or diagnose breast cancer.

Applicants respectfully traverse this rejection.

MPEP 2143.03 states "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is

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nonobvious.

Claim 1, from which claims 3 and 15 depend, is nonobvious from teachings of Gendler et al. as well as Gendler et al. in view of An et al.

In accordance with 35 U.S.C. 103(a), "a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art is such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

As discussed in Section I, supra, claim 1 has been amended to be drawn to an isolated nucleic acid molecule comprising

(a) a nucleic acid molecule comprising a nucleic acid sequence of SEQ ID NO:36; or

(b) a nucleic acid molecule having at least 95% sequence identity to the nucleic acid molecule of (a).

Neither Gendler et al. nor An et al. identically disclose the instant claimed invention. Specifically, neither reference teaches a nucleic acid molecule comprising a nucleic acid sequence of SEQ ID NO:36 or a nucleic acid molecule having at least 95% sequence identity to a nucleic acid sequence of SEQ ID NO:36.

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Further, it would not have been obvious to a person of ordinary skill in the art to modify teachings of Gendler et al. or An et al. to arrive at the claimed isolated nucleic acid molecule.

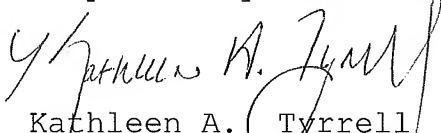
Thus, the instant claimed invention is not obvious over teachings of Gendler et al. or Gendler et al. in view of An et al.

Withdrawal of these rejections under 35 U.S.C. 103(a) is therefore respectfully requested.

### III. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

  
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